

### **REMARKS**

The Final Office Action dated September 30, 2009 notes the following rejections: claims 1-10, 12, 18-27 and 33 stand rejected under 35 U.S.C. § 103(a) over Birru (U.S. Patent Pub. 2002/0037058) in view of Raghaven (U.S. Patent No. 6,115,418); claims 11 and 28 stand rejected under 35 U.S.C. § 103(a) over the '058 and '418 references in view of Johnson (U.S. Patent No. 5,808,574); and claim 17 stands rejected under 35 U.S.C. § 103(a) over the '058 and '418 references in view of Thomas (U.S. Patent Pub. 2004/0013084). Applicant respectfully traverses all claim rejections, and further does not acquiesce to any averment made in the Office Actions of record, unless Applicant explicitly states otherwise.

Applicant acknowledges Examiners response at pages 2-4 of the final Office Action. As discussed in detail below, Applicant addresses the issues raised and maintains that the §103 rejections are improper.

Regarding Examiner's response at page 3 of the Office Action stating that Applicant's arguments fail to clearly point out the patentable novelty and how amendments avoid the presented references, Applicant submits that amendments were made to correct a scrivener's error as suggested by in the Office Action dated April, 3 2009 at page 2.

Applicant respectfully traverses all of the § 103(a) rejections because the cited '418 reference either alone or in combination with the '058 reference lacks correspondence. For example, none of the asserted references teaches the claimed invention "as a whole" (§ 103(a)) including aspects regarding, *e.g.*, an adding means for adding the output signal of said feedback filter means to the output signal of said first section, a feedback filter means for performing a linear filtering of a signal derived from an output signal of said second section, and/or a detector means for extracting samples from the output signal of said adding means. Applicant submits that the '418 reference does not interact to function as a separate section similar to element 402 of the '058 reference as asserted at page 3 of the Office Action. Neither reference appears to teach aspects regarding an interoperable set of first and second sections as claimed. In contrast, the '418 reference teaches an MLT3 input/output signal from which Applicant fails to see how the extraction of samples can be held in connection with the embodiment of Fig. 12 of the '058 reference. *See* the '418 reference at Col. 1:41-45; Col. 2:1-14. Because the '418 and '058

references fail to disclose these operable aspects, no reasonable combination of the references would provide correspondence. As such, the § 103 rejection fails and Applicant requests that it be withdrawn.

Applicant further traverses the § 103 rejections because the cited references teach away from the Office Action's proposed combination. Consistent with the recent Supreme Court decision, *M.P.E.P.* § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('418) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (U.S. 2007). ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."). Applicant submits that the combination would render the invention inoperable for its intended purpose because relied upon aspects of the '418 reference operate by decoding MLT3 decisions whereas the '058 reference teaches (relied upon) a conventional time-domain set of inputs and outputs; the two approaches are inoperable as asserted. In response to the rationale for maintaining the rejection asserted at page 4 of the final Office Action, Applicant does not suggest that the '418 reference teaches that the disclosed circuit cannot be combined with another section for performing additional functions. Rather, Applicant submits that the two particular sections cited from the '418 and '058 references are inoperable when combined as suggested in the Office Action. Applicant submits that the MLT3 decoding process disclosed in the '418 reference would be incapable of processing the conventional time-domain set of output from the cited circuit of the '058 reference. To clarify, the contended §103 issue is not whether the physical combination can be performed, but rather, whether a skilled artisan would be motivated to make the combination given the inoperability of the functions taught by each of the references. Because the '418 reference is incapable of operating for its intended purpose in the proposed combination, a skilled artisan would not be motivated to make the suggested combination from the teachings of the '418 and '058 references. *See In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Under *M.P.E.P.* § 2143.01, Applicant respectfully submits that the rejection cannot be maintained.

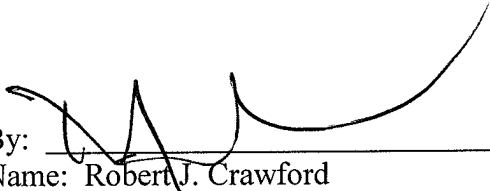
Applicant further traverses the §103(a) rejections of claims 11 and 28 because the '418 reference either alone or in combination with the '058 reference lacks correspondence. Neither of the asserted references appears to relate to the claimed invention when viewed "as a whole"

(§ 103(a)) including aspects regarding a feedback input generator. For example, it is unclear how the cited '418 reference could be interpreted to disclose a "feedback input generator means for receiving said output signal of said second section and providing an output signal ...to said feedback filter means." Page 6 of the final Office Action refers to element 404 of Figure 7 of the '418 reference as disclosing the "detector means" of the claimed invention and element 429 as disclosing the "feedback filter means." As signal line 408 is the only element described in the '418 reference that is connected between the output of element 404 and the input of element 429, Applicant is uncertain which element is cited as disclosing the claimed "feedback input generator means." Because neither reference appears to relate to aspects regarding the feedback input generator means, no reasonable interpretation of the asserted prior art, taken alone or in combination, provides correspondence. As such, a proper rejection has not been presented.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, David Schaeffer, of NXP Corporation at (212) 876-6170.

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